

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-16 and 18-23 are pending, with claims 1, 20 and 23 being the independent claims. Claims 1-4, 11-13, 18, 20, and 23 are sought to be amended. Claim 17 is sought to be cancelled without prejudice or disclaimer of the subject matter therein. Applicants reserve the right to prosecute similar or broader claims, with respect to the cancelled and amended claims, in the future. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Claim Objection

The Examiner objected to claim 1. Based on the amendment to claim 1 above, reconsideration and withdrawal of the objection is respectfully requested.

Rejection under 35 U.S.C. § 101

In the Office Action, page 2, the Examiner rejected Claims 1- 22 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. By the foregoing amendment, claims 1 and 20 have been amended to produce useful, concrete and tangible results. Therefore, claims 1 and 20 do contain statutory subject matter. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection.

Rejection under 35 U.S.C. § 112

On page 3 of the Office Action, the Examiner rejected Claims 1- 23 under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential steps.

Applicants believe the originally filed claims met 35 U.S.C. § 112, second paragraph. However, Applicants have amended the claims for other reasons, and for clarity. Based on the amendments above, Applicants respectfully request the reconsideration and withdrawal of the rejection.

Rejections under 35 U.S.C. § 103

Claims 1 - 10, 14, 15, and 17 - 23

In the Office Action the Examiner rejected claims 1-10, 14, 15, and 17 - 23 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,790,785 to Klug ("Klug") in view of an American Express web page reprinted from archive.org hyperlink labeled December 14, 2001 ("the Web page"). Applicants respectfully traverse.

Although Applicants believe there are technical differences between claim 17 and the applied references, Applicants have cancelled claim 17 for other reasons. Thus, Applicants believe the rejection of this claim has been rendered moot.

Claims 1, 20, and 23 recite features that distinguish over the applied references. For example, claims 1, 20, and 23 recites, using respective language:

(a) receiving a completed first new account application including a plurality of fields associated with personal identification and financial information of a customer;

(b) when the customer is indicated as being an existing customer based on the completed first new application, transmitting a second new account application to the customer, the second new account application including a fewer number of fields for entering personal identification and financial information than the first new account application...

Klug teaches a processing system whereby a user may store "registration information" concerning the user which the user can request be transmitted to other web sites to "which the user desires to register." (*See* Klug, Col. 1, l. 65 - Col. 2, l. 2). The user "determines whether to supply basic information (i.e. requested by a substantial number of third party web sites)" ***or*** "to supply expanded information (i.e. more extensive information about the user ... to register the user at substantially all cooperating third party web sites." (*See* Klug, Col. 7, l. 64 - Col. 8, l. 3). In this manner, it appears, that the user decides whether to supply one or the other, but not both of, a set of "basic" information, which would enable the user to register at a limited number of web sites, or, to supply a set of "expanded" information that supposedly would enable the user to register at a greater number of web sites. The choice to provide one or the other, but not both of, either "basic" personal information or "expanded" information is reinforced in Figure 3 in Klug where the decision block 304 indicates a choice **between** presenting the user with forms for basic information 308 **or** expanded information 312. (*See* Klug, FIG. 3, emphasis added). However, in either situation, the user is only presented with one set of the forms to complete for basic information, which allows registration access to a limited set of web sites, **or** expanded information in order to gain access to a presumably larger set of web sites.

Claims 1, 20, and 23 recite providing a second form if, based on a completed and received first form, the customer is an existing customer. In contrast, Klug appears to offer a system whereby a user must decide between completing only one of two forms based on how much personal information the customer wishes to provide based upon the desired results of registering for a limited number of website or a more expanded number of websites. Klug does not teach at least the above-recited features of claims 1, 20, and 23.

Furthermore, the Web page does not overcome the deficiencies of Klug. On page 5 of the Office Action, the Examiner states that the Web page teaches, which Applicants do not acquiesce to, allowing current customers to note they are already card members before filling out a form and using the Internet for applications. The Examiner states the Web page discloses a web page directing a current card member to "log in before ... apply[ing] for another Card account." Thus, the Web page is not used to teach or suggest, nor does it teach or suggest, and at least the above-recited features of claims 1, 20, and 23, which are lacking from Klug. Therefore, the applied references cannot be used to establish a prima facie case of obviousness for the pending claims.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 20, and 23, and find these claims allowable over the applied references. Also, at least based on their respective dependencies to claims 1 and 20, claims 2-16, 18, 19, 21, and 22 should be found allowable over the applied references, as well as for their additional distinguishing features.

Claims 11 - 13, and 16

In the Office Action the Examiner rejected claims 11 - 13, and 16 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,790,785 to Klug ("Klug") in view of the Web page, and in further view of the Examiner's Official Notice. Applicants respectfully traverse this rejection.

Claims 11-13 and 16, which ultimately depend from independent claim 1, are also patentable over the applied references for reasons similar to those set forth above with respect to claim 1, and further in view of their own respective distinguishing features.

However, Applicants would like to generally address the Examiner's unfounded allegations. On page 8 of the Office Action, the Examiner concedes that Klug and the Web page do not teach the processing of online applications, nor do they provide for acceptance or denial of an application. Applicants submit that the Examiner's Official Notice does not provide the teachings missing from the applied references.

Applicants disagree with the Examiner's conclusion and reasoning on page 15 of the Office Action and dispute the Examiner's statement that "approval and denial of account application, such as for credit card accounts, is old and well known." Applicants respectfully submit that the features recited in claims 1, 20, and 23, as well as in dependent claims 11 - 13, and 16, were not obvious to one of ordinary skill in the art at the time of the invention.

Applicants respectfully point out that pursuant to M.P.E.P. § 2144.03(A), the Examiner cannot remedy the deficiency as noted above in the teaching of the Klug reference merely by asserting what is "old and well known" in the art; rather, the Patent

Office must demonstrate all claim limitations based on substantial evidentiary support.

See *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). For example, this section of the M.P.E.P. states (emphasis added):

[T]he facts asserted to be well-known, or to be common knowledge in the art **are capable of instant and unquestionable demonstration** as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "**capable of such instant and unquestionable demonstration as to defy dispute**" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

Applicants submit that this proof is not found in the conclusory rejection made by the Examiner, and thus the Examiner's use of Official Notice is improper. Applicants remind the Examiner that the Administrative Procedure Act requires that the Examiner's rejections employ "reasoned decision making" based on evidence from a fully developed administrative record. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002).

Patentability determinations which are based on what the Examiner believes is "basic knowledge" and "common," and that otherwise lack substantial evidentiary support, are impermissible. See *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001).

Therefore, Applicants respectfully traverse the rejection on the ground that the aforementioned "Official Notice" lacks "substantial evidentiary support." Thus, the Examiner is asked to produce substantial evidentiary support (e.g., produce a reference) with respect to the subject matter claimed, or withdraw the rejection of these claims.

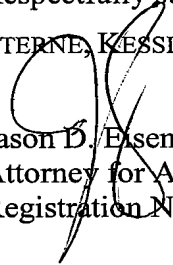
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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